

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAYATO TESHIMA and TAKAAKI ITOH

Appeal No. 95-2088
Application 08/056,882¹

HEARD: JUNE 10, 1998

Before RONALD H. SMITH, METZ and ELLIS, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6, 16, 17, 22 and 25 through 31. Claims 23 and 24 have been withdrawn from consideration by the examiner pursuant to 37

¹ Application for patent filed May 5, 1993.

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CFR § 1.141(b). Claims 1 through 5, 7 through 15 and 18 through 21 have been canceled.

As a preliminary matter we note the appellants' statement on p. 3 of the Brief that all the claims stand or fall together. 37 CFR § 1.192(c)(5)(1994). Accordingly, for purposes of this appeal, we will consider the issues as they apply to representative claim 6.

Claim 6 reads as follows:

6. A method for controlling termites, comprising the step of applying to soil where termites are alive a termite controlling effective amount of a composition comprising:

(a) a termite controlling effective amount of an active agent comprising:

(i) at least one pyrethroid compound selected from the group consisting of "-cyano-3-phenoxybenzyl 2-(4-chlorophenyl)-3-methylbutyrate, 3-phenoxybenzyl 3-(2,2-dihalovinyl)-2,2-dimethylcyclopropanecarboxylate and "-cyano-3-phenoxybenzyl 3-(2,2-dihalovinyl)-2,2-dimethylcyclopropanecarboxylate; and

(ii) N-(2-ethylhexyl)bicyclo [2.2.1]hept-5-en-2,3-dicarboximide; and

(b) an inert carrier.

The references relied on by the examiner are:

Ito et al. (Ito)	4,276,308	Jun. 30,
1981		

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Kimura et al. (Kimura) 63-270610 Nov. 08,
1988
(Japanese Kokai)

Joyce et al. (Joyce), Abstract No. 144583j "Synergism of
Pyrethroids by Piperonyl Butoxide and MGK-264 against
Heliothis virescens, Spodoptera exigua, and Spodoptera
frugiperda (Lepidoptera: Noctuidae)" *Chemical Abstracts*, vol.
109, p. 270 (1988).

Claims 6, 16, 17, 22 and 25 through 31 stand rejected
under 35 U.S.C. § 103 as being unpatentable over Ito, Kimura
and Joyce.

We have carefully considered the arguments advanced by
both the appellants and the examiner and we find ourselves in
complete agreement with the examiner's findings of fact,
conclusions of law and rebuttals to argument.² Accordingly,
we affirm the examiner's rejection and adopt the examiner's
position as our own. We add the following comments only for
clarification.

² We note that the appellant's Reply Brief (Paper No. 13)
was found to be improper by the examiner for failing to
specifically point out the new point(s) of argument in the
Answer. Thus, the examiner refused entry into the record.
Paper No. 15. Accordingly, our decision is based exclusively
on the written record as it appears in the appellants' Brief
(Paper No. 11) and the examiner's Answer (Paper No. 12).

It is well established that the PTO bears the initial burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Piasecki*, 745 F.2d 1468, 1472, 223, USPQ 785, 788 (Fed. Cir. 1984). The examiner must establish that the teachings of the applied prior art would have suggested the present method for controlling termites to a person having ordinary skill in the art, and that such persons would have had a reasonable expectation of success of performing said method. *In re O'Farrell*, 853 F.2d 894, 903-4, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). This suggestion need not be expressly stated in any of the references but, rather, the test of obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Betz*, 418 F.2d 942, 947, 163 USPQ 691, 695 (CCPA 1969).

Based on the collective teachings of the applied prior art, and of Kimura, in particular, we agree with the examiner that it would have been obvious to one of ordinary skill in the art to control termites by applying a composition comprising a known wood pest controlling agent, such as "-

cyano-3-phenoxybenzyl 2-(4-chlorophenyl)-3-methylbutyrate (a.k.a., fenvalerate), and a known efficacy enhancer of wood pest-controlling agents, such as N-(2-ethylhexyl)bicyclo[2.2.1]hept-5-en-2,3-dicarboximide (a.k.a., MGK-264), to the soil. Since both Ito and Kimura teach the use of a composition comprising fenvalerate and an efficacy enhancer to control termites in the soil, and Kimura further teaches the use of the efficacy enhancer MGK-264, specifically, we concur with the examiner that it would have been obvious to one of ordinary skill in the art to arrive at the claimed method. It is considered obvious to employ two known compounds for their known and expected results. ***In re Kerkhoven***, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Throughout the Brief, we find that the appellants' response to the examiner's rejection has primarily focused on the shortcomings of the individual references and has not been directed to the combined teachings of the applied prior art. The appellants argue, individually, that Ito, Kimura and Joyce do not teach a method of applying a combination of fenvalerate

and MGK-264, to soil containing live termites. Brief, pp. 4-5. To that end, we point out that the references were relied on in combination and that the appellants cannot demonstrate nonobviousness by attacking the references individually. ***In re Betz, supra; In re Young***, 403 F.2d 754, 757, 159 USPQ 725, 728 (CCPA 1968).

In addition, we find that the appellants have mischaracterized the teachings of Kimura. According to the appellants Kimura "does not teach or suggest the combination of fenvalerate and MGK 264, much less a method as recited in claim 6 whereby a composition containing fenvalerate and MGK 264 is applied to soil where termites are alive." Brief, p. 4, last para. We disagree. As discussed above, Kimura describes his invention as being directed to a composition comprising a wood pest-controlling agent and an efficacy enhancer. Kimura, p. 3. Kimura points to a limited list of efficacy enhancers, which includes the well-known enhancer, MGK-264. Kimura teaches that the disclosed efficacy enhancers will work effectively with **"any"** insecticides belonging to pyrethroid compounds [emphasis added]." Kimura, p. 6, lines

1-2. Kimura further teaches that fenvalerate is one of those pyrethroid compounds whose activity will be enhanced. Thus, we do not find from the facts before us that those of ordinary skill in the art would need to pick and choose from two broad genera of compounds to arrive at the present method. Rather, we find Kimura teaches that all combinations will work. That is, Kimura states that each of the disclosed efficacy enhancers will increase the effects of each of the wood pest-controlling agents listed. From such teachings, it is reasonable to conclude that the claimed method of using the known wood pest-controlling agent, fenvalerate, in combination with a known efficacy enhancer of wood pest-controlling agents, MGK-264, would have been obvious to one of ordinary skill in the art at the time the application was filed.

As to the appellants' contention that Kimura does not teach the application of the compositions disclosed therein to soil containing live termites, we agree with the examiner that this claim limitation is clearly suggested by the reference. See Kimura, p. 15, the penultimate sentence.

After a ***prima facie*** case of obviousness under 35 U.S.C.

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§ 103 has been established by the examiner, the burden of going forward shifts to the appellants. ***In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In response, the appellants can submit objective evidence of nonobviousness. Such evidence can include unexpected results, commercial success, long-felt need in the industry, etc. ***Graham v. John Deere Co.***, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

In the case before us, the appellants urge that they achieved unexpectedly superior results when a composition comprising fenvalerate and MGK-264 is added to soil containing live termites. Brief, pp. 6-7. The appellants rely on Table 1 in the specification to support their position. We find this argument unpersuasive for several reasons.

First, we point out that representative claim 6 does not require any specific mortality rate for termites in the treated soil. Rather, the claim only requires the application of an "effective amount" of a composition comprising fenvalerate and MGK-264. The applied prior art demonstrates that "effective"

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amounts of the claimed compounds were well known in the art at the time the application was filed.

Second, for a showing of unexpected results to be probative evidence of nonobviousness, the appellant must establish (i) that there is a difference between the results obtained for the claimed invention and those of the prior art, and (ii) that the difference obtained is significant and would not have been expected by a person having ordinary skill in the art at the time the invention was made. *In re Freeman*, 474 F.2d 1318, 1324, 177 USPQ 139, 143 (CCPA 1973); *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971). This the appellants have not done.

An efficacy enhancer by definition is a compound which enhances, or increases, the effectiveness of another compound. Therefore, it is reasonable to conclude that those skilled in the art would have expected that a compound known to increase the effectiveness of termite-controlling agents, in general, and of fenvalerate, in particular, would result in an increased mortality rate in termites when applied to the soil. We

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direct attention to the teachings of Kimura that compositions comprising a wood pest-controlling agent and an efficacy enhancer "exhibit extremely superior effects." Kimura, p. 5, lines 1-4. According to Kimura, such a composition is "much superior in its controlling effect on termites and wood borers, as well as in its preservative effect." *Id.*, para. 4. Thus, in view of the teachings of Kimura, we find that one of ordinary skill in the art would have expected that a combination of fenvalerate and MGK-264 would increase the mortality rate in termites when applied to the soil.

Accordingly, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

RONALD H. SMITH
Administrative Patent Judge

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